

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DEBORAH Z. ALTSCHULER

Appeal No. 2002-2206
Application No. 09/054,211

ON BRIEF

Before FRANKFORT, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13, 14, 19, 20 and 22-26. Claim 11, the only other claim remaining in this application, stands allowed.

BACKGROUND

The appellant's invention relates to an apparatus and method for the mechanical removal of pests and their eggs from hair and fur, the apparatus including a comb used

to remove pests and their eggs from hair and fur and a device for removal of pests and eggs from the comb. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Franklin	2,610,638	Sep. 16, 1952
Morrison	5,600,865	Feb. 11, 1997
Guinard (French patent document)	827,463	Apr. 27, 1938
Peyron (French patent document)	945,585	Nov. 29, 1948

The following rejections are before us for review.

Claim 26 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.¹

Claim 13 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Franklin.

Claims 14, 22, 23 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guinard in view of Morrison.

Claims 19, 20, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyron in view of Franklin.

¹ The examiner has not expressly repeated this rejection in the answer in light of appellant's concession on page 1 of the brief that claim 26 requires correction. As it is apparent from appellant's comments on pages 3-4 of the brief that appellant wishes to continue to pursue claim 26 in this application and that the examiner has not withdrawn this rejection, we shall consider this rejection to be included as part of this appeal.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 18 and 25) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 24 and 26) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The examiner has rejected claim 26 as being indefinite because “the planar base” lacks antecedent basis and appellant has not disputed the examiner’s position. Rather, appellant has indicated an intention to amend claim 26 to replace the terminology “planar base” with “plate” upon the resolution of this appeal. Accordingly, we summarily sustain this rejection. We also note, however, in accordance with our authority under 37 CFR § 1.196(c), that amendment of claim 26 to replace both occurrences of “planar base” with “plate” would overcome this rejection.

The anticipation rejection

Claim 13 calls for a device for removal of pests and pest eggs from a comb having, inter alia, a plurality of teeth having separations therebetween sized to

accommodate a few hairs, the device comprising a planar base having a plurality of apertures, each aperture sized to receive and closely fit one of the plurality of teeth. Franklin (Figure 10) discloses a comb provided with a device (cleaning member 15^b) having a planar base 16^b, the base having a plurality of slots 17 made of the same size and spacing as are the teeth of the comb. Appellant argues that the subject matter of claim 13 is not anticipated by Franklin because “the teeth of Franklin’s comb are relatively widely spaced, accommodating more than a few hairs between each pair of teeth” (brief, page 3) and that, hence, the slots 17 of Franklin’s cleaning member are likewise relatively widely spaced and thus cannot respond to the apertures recited in claim 13.

Appellant is correct that, notwithstanding that the comb and its teeth are not positively recited as part of claim 13, the recited relationship of the apertures of the device of claim 13 to the teeth of the comb does structurally limit the recited device. In particular, claim 13 calls for the apertures to be sized to receive and closely fit a plurality of teeth having separations therebetween sized to accommodate a few hairs. It is our opinion, however, that the slots of Franklin’s cleaning member meet this limitation. First, we note that appellant’s claim 13 does not require that the apertures be sized to receive and closely fit teeth having separations therebetween sized to accommodate only a few hairs. Appellant expressly concedes on page 3 of the brief that the teeth of Franklin’s comb, and hence the apertures of the cleaning device, are spaced to accommodate more than a few hairs therebetween. It thus follows that they

are spaced to accommodate a few hairs, as called for in claim 13. Moreover, the term “few” is defined as “not many, a small number”² and appellant has not expressly defined this term as being limited to a particular number.³ One of ordinary skill in the art would certainly infer from Franklin’s disclosure that “[d]ue to the close spacing of the teeth of an ordinary comb, hairs and other matter become lodged therebetween” (column 1, lines 6-8), that the teeth of such combs have separations therebetween sized to accommodate a small number of hairs, with the slots of the cleaning device for the comb being similarly spaced (column 3, lines 21-24).

For the foregoing reasons, we conclude that Franklin’s cleaning member 15^b fully responds to the limitations of claim 13. Accordingly, we sustain the rejection of claim 13 as being anticipated by Franklin.

The obviousness rejections

Turning first to the rejection of claim 14 as being unpatentable over Guinard in view of Morrison, the examiner recognizes that Guinard does not disclose “a plate having two parallel rows of spaced apertures, each aperture sized to receive one of said teeth [of the comb] wherein said plate is seated upon both of said first layer of teeth and said second layer of teeth” as called for in claim 14. To overcome this

² Webster’s New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

³ In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

deficiency, the examiner contends that it would have been obvious to one skilled in the art to provide the apparatus of Guinard with such a plate in view of Morrison in order to easily and effectively remove debris from the teeth and the spaces therebetween (see answer, page 5).

Appellant does not dispute the examiner's basic position that it would have been obvious to provide a cleaning plate for Guinard's comb, the cleaning plate having two rows of apertures sized to receive the teeth of Guinard's comb. Rather, appellant argues that neither Guinard nor Morrison describes a comb having teeth sufficiently closely spaced to remove nits and lice and that, even if Guinard's comb were modified by spacing the teeth more narrowly, it would not have been obvious to use the device of Morrison to clean the comb, because such a device would be expected to be too weak for use (brief, page 4).

We appreciate that neither Guinard nor Morrison discloses use of a comb for the purpose of mechanical removal of pests and their eggs from hair and fur. While a comb having more closely spaced teeth than that of Guinard might be more efficient and thorough for removing some pests and their eggs from hair or fur, Guinard's comb is certainly capable, without modification, of trapping some pests and eggs in the spaces between the teeth of the comb (note the close spacing illustrated in Guinard's Figure 1).

Additionally, for the reasons discussed above with regard to claim 13, we consider the spacing of the teeth of Guinard's comb to meet the limitation in claim 14 of

“the teeth having separations therebetween sized to accommodate a few hairs” without modification. Moreover, the examiner has not proposed that Guinard’s comb be modified so as to more closely space the teeth thereon. Thus, in that appellant’s sole argument against the examiner’s rejection of claim 14 as being unpatentable over Guinard in view of Morrison is not pertinent to the examiner’s rejection, it follows that we do not find it persuasive of any error on the part of the examiner. We thus shall sustain the rejection of claim 14 as being unpatentable over Guinard in view of Morrison.

We shall not, however, sustain the examiner’s rejection of claims 22, 23 and 26 as being unpatentable over Guinard in view of Morrison. Appellant has pointed out on page 4 of the brief that the examiner has not provided any reference for the use of a comb with a cleaning device for the diagnosis of infestations of lice and the examiner has not responded to this argument. The examiner’s statement on pages 5 and 6 of the answer that “to use the comb of the above combination for removal of lice would have been obvious ... as it is well known to use fine toothed combs for such purpose as evidenced by the various references previously recited by applicant and the examiner” (emphasis added) is of no avail in responding to appellant’s argument, in that it does not address diagnosing an infestation of pests as called for in claim 22 and claims 23 and 26 depending therefrom. Moreover, the “various references” alluded to by the examiner have been given no consideration in reviewing this rejection as they were not positively included in the rejection (see Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd.

Pat. App. & Int. 1993)) and as we will not speculate as to which particular references the examiner alludes.

Turning next to the rejection of claims 19 and 20 as being unpatentable over Peyron in view of Franklin, appellant does not dispute that Peyron discloses an apparatus for the mechanical removal of pests and pest eggs from hair and fur, the apparatus comprising a solid handle and a plurality of teeth as recited in claim 19. Rather, appellant's only argument with respect to claims 19 and 20 is that one of ordinary skill in the art would not have been motivated to combine a relatively flat cleaning device, such as that of Franklin, with a lice comb having closely spaced teeth, because the close spacing of the apertures would be expected to result in too fragile a device (see brief, page 5).

We find nothing in either Peyron or Franklin which supports appellant's contention that one skilled in the art would expect a cleaning member of the type disclosed by Franklin, if adapted to accommodate the teeth of Peyron's lice comb, to be too fragile a device and appellant has provided no evidence to support this contention. An attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Accordingly, we do not find appellant's argument persuasive of the nonobviousness of the subject matter of claim 19. Accordingly, we shall sustain the examiner's rejection of claim 19. We note that the appellant has not argued separately the patentability of claim 20 apart from claim 19. Therefore, claim 20 falls with representative claim 19 (see In re Young, 927 F.2d

588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)). The rejection of claim 20 is thus also sustained.

We shall not, however, sustain the examiner's rejection of method claims 24 and 25, as the examiner has not addressed appellant's argument on page 5 of the brief that the applied prior art references provide no suggestion to use a comb having a removing means as claimed for the purpose of diagnosing infestations.⁴

CONCLUSION

To summarize, the decision of the examiner to reject claim 26 under the second paragraph of 35 U.S.C. § 112 and claim 13 under 35 U.S.C. § 102(b) is affirmed. We have also made a recommendation in accordance with 37 CFR § 1.196(c) to overcome the rejection of claim 26 under the second paragraph of 35 U.S.C. § 112. The examiner's decision to reject claims 14, 22, 23 and 26 is affirmed as to claim 14 and reversed as to claims 22, 23 and 26. The examiner's decision to reject claims 19, 20, 24 and 25 is affirmed as to claims 19 and 20 and reversed as to claims 24 and 25.

A statement pursuant to 37 CFR § 1.196(c) has been made in this decision. A time period in which the appellant may file an amendment for the purpose stated in § 1.196(c) is hereby set to expire TWO MONTHS FROM THE DATE OF THIS DECISION.

⁴ Our remarks, supra, with respect to the examiner's treatment of claims 22, 23 and 26 likewise apply to the examiner's treatment of claims 24 and 25. Upon return of this application to the Technology Center, however, the examiner may wish to consider whether it would have been obvious to one using a cleaning member as taught by Franklin with a lice comb as taught by Peyron to first inspect the cleaning member 15^b to see if it needs to be cleaned, as taught by Franklin in column 3, lines 16-18, thereby also determining whether pests or their eggs were present in the hair combed with Peyron's lice comb.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(c)

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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